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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,856	05/30/2001	Koji Hattori	P/1071-1358	9007
32172	7590	08/10/2004	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) 41 ST FL. NEW YORK, NY 10036-2714			LOPEZ, CARLOS N	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/867,856

Applicant(s)

HATTORI ET AL.

Examiner

Carlos Lopez

Art Unit

1731

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-13.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The proposed new limitation directed to the "not more than about 1/25 of the average particle size" requires further consideration and new search. In the first action mailed on 11/06/03 it was noted to applicant, through a 112 second paragraph rejection, that the instant claims recited a narrow limitation (not more than about 1/5) within a broader limitation (of more than 1/25). In response to the rejection applicant noted the following:

"The claims refers to decomposing a solution in which the raw material powder has an average particle size which is not more than about 1/5 of the average particle size of the glass powder. The claim then goes on to indicate that when this condition is satisfied (i.e., not more than about 1/5 of the average particle size), the decomposition temperature itself satisfies the recited characteristics depending on certain other conditions, one of which relates to the particle size being more than about 1/25 of the average particle size. In other words, the 1/5 and 1/25 relate to different aspects of the claims and do not create an inconsistency by calling for a value in broad and narrow range of the same parameter to be present at the same time."

As shown above applicant noted on the record that the 1/5 and 1/25 limitation are different aspects of the claim and further reaffirmed the "more than about 1/25" limitation. Hence the claim has always been treated, as explicitly recited in the claims and noted by applicant, of having the "more than about 1/25" limitation. Applicant now argues that there is an obvious omission of the term "not" in the instant claims, which changes the "more than about 1/25" limitation to "not more than about 1/25" limitation. Clearly, said new limitation is thus indeed a new limitation requiring further consideration and search since now the instant claims recite the "not more than 1/25" limitation.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments filed on 7/14/04 have been fully considered but they are not persuasive. Applicant argues that the Kodas reference does not disclose an aqueous medium. As noted in the body of the rejection "As shown in col. 26, lines 35ff, the liquid feed line 102 comprises metal precursors (deemed as the claimed water-soluble compound) such as nitrates, acetates and chlorides of a metal, which are highly soluble. In Col. 30, lines 31ff, the liquid solution comprises a raw material oxide powder (SiO_2) and a precursor for the intermediate oxides (Al_2O_3). Thus the liquid feed line comprises a mixed solution having the claimed raw material oxide powder (SiO_2), water-soluble compound (nitrates, acetates and Applicants arguments are based on limitations not recited in the claims." While Kodas does not explicitly disclose that the liquid is aqueous it is understood in the art that if a solution includes water soluble compounds in its dissolved form, the solvent used, absent any indication, would be water. Applicant is also referred to Rosencwaig, which notes in the abstract that the liquid which is sprayed-thermally to obtain glass powder is an aqueous solution.

Applicant also argues that the ratio of particle size range of the raw material oxide to the size of the glass powder is an extremely large number and that there is nothing in Kodas that would suggest a raw material oxide powder not more than 1/5 of the average particle size of the glass powder. Said argument does not negate the fact that Kodas disclose and envisages the claimed ratio. Nor has applicant provided any unexpected results concerning the 1/5 ratio.

In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., pyrolysis temperature should vary depending on the relative amount of raw material oxide powder based on the total of the powder and the amount of water soluble compound in an aqueous solution) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is noted that the instant claims do not recite that the pyrolysis temperature is a function of raw material amount and amount of water soluble compound. The claims only recite different scenarios wherein the pyrolysis temperature is changed based on raw material amount and amount of water soluble compound for which Kodas reads on to at least one of those scenarios. The claims do not recite a step of determining the pyrolysis temperature based on raw material and amount of water soluble compound as argued. Again it is emphasized that the instant claims only recited different scenarios wherein the pyrolysis/decomposition temperature is varied based on the selected raw material amount and amount of water soluble compound. Hence there is no "determining" step limitation as argued.

In regards to the argument that Kodas does not show the significance of 45% and 1/25, it is noted that it is not required to show the significance of 45% and 1/25. If there is a requirement for showing the significance of 45% or 1/25, it is asked what is the required significance to be shown?

Applicant also argues that Kodas teaches away from claims 8,9,12 and 15 because the feed line only discloses a 15% raw material oxide powder. It is noted that Kodas specifically discloses that the concentration of the solutes in the solution would depend on the desired size of the glass powder. Hence showing that if a bigger glass powder is desired, a higher concentration of solutes, such as those recited in claims 8, 9,12 and 15, would be required. Thus while Kodas give examples using 15% it does not constitute a teaching away.

The argument that Kodas neither Rosencwaig teach that the temperature of the pyrolysis should be a function of the amount and size of raw material oxide powder is found unpersuasive since the argued limitation is not claimed..



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